

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: DuWayne C. Radke et al. Examiner: Christy Marie Green  
Serial No.: 09/904,124 Group Art Unit: 3635  
Filed: July 12, 2001 Docket No.: M120.199.101 (56908US002)  
**Due Date: February 22, 2005** (with one-month extension)  
Title: PASS-THROUGH FIRESTOP DEVICE

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**APPEAL BRIEF**

**Mail Stop Appeal Brief – Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir/Madam:

This Brief is submitted in support of the Notice of Appeal filed on November 22, 2004, appealing the Final Office Action mailed September 22, 2004.

The U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account No. 50-0471 in the amount of \$500.00 for filing a Brief in Support of an Appeal as set forth under 37 C.F.R. §§ 1.17(b) and 1.191(a) and the modified fee schedule effective December 8, 2004, and an amount of \$120.00 for a one-month extension as set forth under 37 C.F.R. § 1.136(a)(1). At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account No. 50-0471.

Appellant respectfully requests reversal of the Examiner's rejection of pending claims 1-4, 6, 7, 10, 15, 16, 18, and 19.

**Appeal Brief to the Board of Patent Appeals and Interferences**

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**TABLE OF CONTENTS**

Real Party in Interest.....	3
Related Appeals and Interferences.....	3
Status of Claims.....	3
Status of Amendments.....	3
Summary of the Claimed Subject Matter.....	3
Grounds of Rejection to be Reviewed on Appeal.....	5
Argument.....	5
Conclusion.....	14
Appendix.....	<i>i</i>

**Appeal Brief to the Board of Patent Appeals and Interferences**

Applicant: DuWayne C. Radke et al.

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**REAL PARTY IN INTEREST**

The intellectual property embodied in the pending application has been assigned to 3M Innovative Properties Company, a Delaware corporation doing business in Saint Paul, Minnesota.

**RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present Appeal.

**STATUS OF CLAIMS**

In a Final Office Action mailed September 22, 2004, claims 1-4, 6, 7, 10, 15, 16, 18, and 19 were finally rejected. Claims 5, 11-14, 17, and 20 were objected to. Claims 8-9 have been canceled. Claim 21 has been withdrawn. Claims 1-7 and 10-20 are pending in the application. Claims 1-4, 6, 7, 10, 15, 16, 18, and 19 are the subject of the present Appeal.

**STATUS OF AMENDMENTS**

In an Amendment After Final filed November 22, 2004, an attempt was made to amend claim 20 to correct an unintentional grammatical error unrelated to patentability. However, in an Advisory Action mailed December 17, 2004, the Examiner stated that for purposes of Appeal, the proposed amendment would not be entered as "the issues raised within the arguments would require further consideration and an updated search . . ." (emphasis added). Although it is not understood why this reasoning precludes entry of the proposed amendment to claim 20, the claims set forth in the Appendix reflect the status of the claims as of the Final Office Action mailing date of September 22, 2004.

**SUMMARY OF THE CLAIMED SUBJECT MATTER**

The claimed invention addresses the need for a cast-in-place pass through firestop device for providing a heat sealable passageway through partitions formed in floors, walls, or ceilings to permit the running of cables, wires, pipes, and the like. In this regard, and unlike previous

**Appeal Brief to the Board of Patent Appeals and Interferences**

Applicant: DuWayne C. Radke et al.

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---

designs, the cast-in-place pass through firestop device can be quickly and easily installed (and properly sized) in partitions having varying thicknesses. With reference to the language of independent claim 1, a firestop device 2 for providing a passage through a partition in a structure includes a housing 4 and a firestop material 26 arranged within the housing 4. In this regard, the housing includes at least one frangible connection 20a-d defining a removable band 18a-d. *See, e.g., Application* at page 3, lines 10-15; page 6, line 29 through page 7, line 19; and FIGS. 1-3b. During use, one or more of the removable bands can easily be removed from the housing such that the resultant structure desirably approximates a thickness of the partition to which it is installed.

With reference to the language of independent claim 18, a firestop device 2 for providing a passage through a partition in a structure includes a housing 4 having first 6 and second 8 opposed open ends and a hollow chamber 10 having a longitudinal axis extending from the first open end 6 to the second open end 8. The housing 4 includes a cylindrical base 4a portion having a diameter and a cylindrical riser 4b portion having a diameter smaller than the base diameter. The base 4a portion includes an annular sidewall 14 portion extending from the first 6 open end toward the riser 4b portion, and a shoulder 17 portion extending radially inwardly from the sidewall 14 portion to the riser 4b portion. To this end, the sidewall 14 portion and the shoulder 17 portion define an annular recess 24 for receiving firestop material 26. The sidewall 14 and the shoulder 17 portions include inner surfaces having inwardly extending ribs 14a, 17a, respectively. The riser 4b portion includes a plurality of longitudinally arranged, frangibly connected circumferential bands 18a-d having equal axial lengths. In this regard, each band 18a-d includes a radially outwardly extending pull tab 22a-d that can be used to manually remove a band 18a-d from the riser 4b portion along a frangible connection 20a-d, thereby reducing the height of the device in accordance with the thickness of the partition into which the device is installed. *See e.g., Application* at page 7, line 5 through page 8, line 24; and Figs. 3a through FIG. 6.

**Appeal Brief to the Board of Patent Appeals and Interferences**

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**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

- I. Claims 1-4, 10, 15, 16, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Münzenberger et al., U.S. Patent No. 6,161,873 (“Münzenberger”) in view of Rodriguez et al., U.S. Patent No. 5,588,267 (“Rodriguez”).
- II. Claims 1-4, 10, and 18 stand rejected under the judicially-created Doctrine of Obviousness-Type Double Patenting over Radke et al., U.S. Patent No. 6,694,684 (“Radke”).

**ARGUMENT**

**I. The Applicable Law**

“Patent Examiners carry the responsibility of making sure that the standard of patentability annunciated by the Supreme Court and by the Congress is applied in each and every case.” MPEP 2141 (emphasis in the original). The Examiner bears the burden under 35 U.S.C. § 103 in establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Three criteria must be satisfied to establish a *prima facie* case of obviousness. First, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would teach, suggest, or motivate one to modify a reference or to combine the teachings of multiple references. *In re Fine* at 1074. Second, the prior art can be modified or combined only so long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 2315 USPQ 375, 379 (Fed. Cir. 1986). Third, the reference or combined references must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (C.C.P.A. 1974).

The court in *Fine* stated:

Obviousness is tested by “what the combined teaching of the references would have suggested to those of ordinary skill in the art.” But it “cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” And “teachings of references can be combined *only* if there is some suggestion or incentive to do so.”

**Appeal Brief to the Board of Patent Appeals and Interferences**

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Serial No.: 09/904,124

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---

*In re Fine*, 5 USPQ2d at 1599 (citations omitted).

There must be some teaching somewhere that provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem that it addresses. *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988); *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (C.C.P.A. 1979).

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). Furthermore, claims must be interpreted in light of the specification, claim language, other claims, and prosecution history. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987). At the same time, a prior patent cited as a § 103 reference must be considered in its entirety, “i.e. as a whole, including portions that lead away from the invention.” *Id.* That is, the Examiner must recognize and consider not only the similarities, but also the critical differences between the claimed invention and the prior art as one of the factual inquiries pertinent to any obviousness inquiry under 35 U.S.C. § 103. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990) (emphasis added). Finally, the Examiner must avoid hindsight. *Id.*

An applicant is entitled to a patent grant if all the elements of a *prima facie* case of obviousness are not established. The Federal Circuit has endorsed this view in stating: “If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1448 (Fed. Cir. 1992).

The *prima facie* case of obviousness cannot be established if the references employed are not in the inventor’s field of endeavor, or reasonably pertinent to the specific problem with which the inventor was involved. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

References within the statutory terms of 35 U.S.C. § 102 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658, 23 USPQ2d 1058 (Fed. Cir. 1992). Two factors define whether a reference is

**Appeal Brief to the Board of Patent Appeals and Interferences**

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Serial No.: 09/904,124

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Docket No.: M120.199.101 (56908US002)

Title: PASS-THROUGH FIRESTOP DEVICE

---

analogous art: (1) when the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313 (Fed. Cir. 1986).

Substantial evidence must support the PTO's factual assessment of the field of endeavor. *In re Bigio*, 381 F.3d 1320, 1326, 72 USPQ2d 1209 (Fed. Cir. 2004) (citing *In re Gartside*, 203 F.3d 1305, 1315 (Fed. Cir. 2000)). Quoting Judge Rader: "In other words, the PTO must show adequate support for its findings on the scope of the field of endeavor in the applicant's written description and claims, including the structure and function of the invention." 381 F.3d at 1326.

Regarding the inventor's field of endeavor, the Federal Circuit offers this reminder:

We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances"-in other words, common sense- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

*In re Oetiker* at 1446 (quoting *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (C.C.P.A. 1979)).

"A reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem . . . If is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

**Appeal Brief to the Board of Patent Appeals and Interferences**

Applicant: DuWayne C. Radke et al.

Serial No.: 09/904,124

Filed: July 12, 2001

Docket No.: M120.199.101 (56908US002)

Title: PASS-THROUGH FIRESTOP DEVICE

---

**II. Rejection of Claims 1-4, 10, 15, 16, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Münzenberger et al., U.S. Patent No. 6,161,873 (“Münzenberger”) in view of Rodriguez et al., U.S. Patent No. 5,588,267 (“Rodriguez”).**

**A. Rodriguez is Non-analogous Art.**

A requisite *prima facie* case of obviousness cannot be established if the references employed are not in the inventor’s field of endeavor, or reasonably pertinent to the specific problem with which the inventor was involved. *Deminski* at 442 (referenced hereinafter as “the analogous art two-factor standard”). Rodriguez is neither within field of endeavor associated with the pending application (i.e., pass through firestop devices), nor reasonably pertinent to the problem of installing cast-in-place pass through firestop devices in partitions of varying thicknesses.

Claims 1-4, 10, 15, 16, 18, and 19 have been rejected in four separate Office Actions under 35 U.S.C. § 103(a) as being unpatentable over Münzenberger in view of Rodriguez. By way of reference, the Examiner has alleged that: “Rodriguez teaches that it is known in the art to provide at least one frangible connection (20) defining a removable band (where 5 points to); and a pull tab (25) providing a grasping means (column 4, lines 28-34).” *Final Office Action* mailed September 22, 2004 at page 5, lines 6-8. In each of Appellant’s previous Responses to this rejection, it has been argued that Rodriguez is non-analogous art, and thus not available as a reference under Section 103. In each subsequent Action by the Examiner, including the current Final Office Action, the Examiner has not once offered “adequate support for findings on the scope of the field of endeavor in the applicant’s written description and claims” as required by the Federal Circuit. *Bigio* at 1331.

In particular, while the Examiner has recited the analogous art two-factor standard, the Examiner has yet to apply either factor. For example, in the current Final Office Action, at page 6, the Examiner recites the analogous art determination criteria, but does not make a determination as to whether Rodriguez is within the field of the applicant’s endeavor. Nor does the Examiner make a determination as to whether Rodriguez is reasonably pertinent to the



**Appeal Brief to the Board of Patent Appeals and Interferences**

Applicant: DuWayne C. Radke et al.

Serial No.: 09/904,124

Filed: July 12, 2001

Docket No.: M120.199.101 (56908US002)

Title: PASS-THROUGH FIRESTOP DEVICE

---

particular problem with which the applicant was concerned. Instead, the Examiner argues (quoting):

The fact that the applicant states that it is not within the applicant's field of endeavor, namely firestopping; if the prior art structure is capable of performing the intended use (which would be removing a band – in reference to a frangible section, or a grasping means – in reference to a pull tab, then it meets the claim (sic).

*Final Office Action* mailed September 22, 2004 at page 6, line 10.

The Examiner's argument is irrelevant to the non-analogous art inquiry in that it does not matter whether Rodriguez "meets the claim." Instead, the question is whether Rodriguez is in the same field of endeavor, and if not, whether Rodriguez is reasonably pertinent to the particular problem with which the applicant was concerned.

Appellant notes that substantial evidence must support the PTO's factual assessment of the field of endeavor. *In re Bigio* at 1326. In the absence of a showing of substantial evidence supporting an assessment of the field of endeavor, Appellant is entitled to a patent grant because: "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker* at 1446.

A proper application of the analogous art two-factor standard necessitates the conclusion that Rodriguez is non-analogous art. With regard to factor (1), the applicant's field of endeavor is a firestop device, and more particularly, a cast-in-place firestop device for passing cables, pipes, and the like through a concrete partition. *Application* at page 1, lines 7-9. The Examiner admits Rodriguez relates to roof flashing. *Final Office Action* mailed September 22, 2004 at page 6, line 4. Thus, Rodriguez is clearly not in the field of the applicant's endeavor, such that a criterion (1) is not satisfied.

With regard to factor (2), the particular problem with which the present invention is concerned is creating a firestop opening in a partition, and adjusting the height of the firestop device to match the thickness of the partition. *Application* at page 6, lines 2-5. In particular, and with reference to FIG. 6, the length of the firestop device 2 has been adjusted to match a thickness of a concrete floor 44 surrounding an exterior of the firestop device 2 by a selective removal of one or more of the band(s) 18a-d.

**Appeal Brief to the Board of Patent Appeals and Interferences**

Applicant: DuWayne C. Radke et al.

Serial No.: 09/904,124

Filed: July 12, 2001

Docket No.: M120.199.101 (56908US002)

Title: PASS-THROUGH FIRESTOP DEVICE

---

In contrast, Rodriguez seeks to address the problem of altering an effective inner diameter of a roof flashing device within which a pipe is disposed. *Rodriguez* at column 3, lines 55-65 (explaining an assembly for a larger diameter pipe). Specifically, Rodriguez teaches establishing a weatherproof seal around different diameter pipes (*Rodriguez* at column 1, lines 33-37). For a smaller diameter pipe, the flashing 1 assumes the form shown in FIG. 2, including an upper seal 8 having edge seals 10, 11 that define an inner diameter. As shown in FIG. 1, the upper seal 8 seals against the smaller diameter pipe P. To accommodate a larger diameter pipe (such as the pipe P' of FIG. 5), the upper seal 8 is removed. Once the upper seal 8 is removed, and as shown in FIG. 4, the intermediate seal 9 (otherwise including edge seals 12, 13) defines the inner diameter of the flashing 1, with the inner diameter of the intermediate seal 9 being greater than the inner diameter of the seal 8 (see, FIG. 2). This larger inner diameter is able to accommodate the larger diameter pipe P', as shown in FIG. 5. Rodriguez is entirely unconcerned with the overall height or length of the flashing 1; instead, the above-described ability to alter an inner diameter is the problem being addressed. Thus, the particular problem addressed by Rodriguez is not reasonably pertinent to adjusting a height of the firestop device to match a thickness of the partition. Therefore, it is respectfully submitted that one of ordinary skill in the art seeking to solve the problem of adjusting a height (or length) of a firestop device within a partition would not reasonably be expected or motivated to look to roof flashing articles having an adjustable inner diameter.

Appellant submits that neither factor of the analogous art two-factor standard has been satisfied, such that Rodriguez cannot be applied as a reference under Section 103. Thus, Appellant requests that the Board reverse the rejections of claims 1-4, 10, 15, 16, 18, and 19 under 35 U.S.C. § 103 based upon Münzenberger in view of Rodriguez.

**B. A Requisite Suggestion to Modify Münzenberger Does Not Exist.**

Relative to each of the rejections under §103, even if Rodriguez is deemed analogous, the Examiner has not established a *prima facie* case of obviousness. A *prima facie* case of obviousness requires the Examiner to establish a suggestion or motivation to modify a reference or to combine reference teachings. *MPEP* §2143. To this end, the “level of skill in the art”

**Appeal Brief to the Board of Patent Appeals and Interferences**

Applicant: DuWayne C. Radke et al.

Serial No.: 09/904,124

Filed: July 12, 2001

Docket No.: M120.199.101 (56908US002)

Title: PASS-THROUGH FIRESTOP DEVICE

---

cannot be relied upon to provide the requisite suggestion to combine. *MPEP* §2143.01. Further, the mere fact that references could be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *MPEP* §2143.01.

In the current Final Office Action, the Examiner states: “[I]t would have been obvious . . . to provide the frangible connection of the housing and the pull tab to grasp the band of Rodriguez with the housing of the firestop device of Münzenberger in order to provide different lengths of the housing for different sized walls (column 1, lines 35-37).” *Final Office Action* mailed September 22, 2004 at page 5, lines 8-13. This alleged “motivation” does not exist in Münzenberger. The language referenced by the Examiner (Münzenberger at column 1, lines 35-37) relates to the fact that in different countries, the effective outer diameter of firestop fixtures may differ. This has absolutely nothing to do with providing a firestop housing having different lengths. Thus, in the absence of any suggestion or motivation to modify Münzenberger in view of Rodriguez, it is respectfully submitted that a *prima facie* case of obviousness has not been made. Therefore, Appellant requests that the Board reverse the rejections under 35 U.S.C. § 103 of claims 1-4, 10, 15, 16, 18, and 19.

**C. Further Deficiencies In The Obviousness Rejection of Claim 1.**

Independent claim 1 requires, amongst other limitations, a firestop device having a housing including at least one frangible connection defining a removable band. With this in mind, the Final Office Action mailed September 22, 2004 states that Münzenberger discloses a firestop device, but does not disclose a housing including at least one frangible connection defining a removable band. The Examiner asserts that Rodriguez teaches “a frangible connection (20) defining a removable band (where 5 points to).” *Final Office Action*, mailed September 22, 2004, page 5.

It is respectfully noted that the Examiner has not consistently articulated which elements of Rodriguez are supposedly being combined into Münzenberger. In particular, the Examiner has inferred the ribs 8 of Münzenberger as being the claimed band. *Final Office Action*, mailed September 22, 2004 at page 5, line 1; *Office Action* mailed September 12, 2002 at page 3, lines

**Appeal Brief to the Board of Patent Appeals and Interferences**

Applicant: DuWayne C. Radke et al.

Serial No.: 09/904,124

Filed: July 12, 2001

Docket No.: M120.199.101 (56908US002)

Title: PASS-THROUGH FIRESTOP DEVICE

---

7-9. If so, in order for the rib 8 of Münzenberger to “removable” in accordance with claim 1, the internal annular groove 20 of Rodriguez would have to be formed below the top-most rib 8 (relative to the orientation of FIGS. 1 and 2 of Münzenberger). There is simply no motivation for providing an annular groove at this location, as to do so would, upon removing the top-most rib 8 and thus all portions of the pipe 7 above this rib 8, render the firestop device unfit for its intended purpose as it would be much too short (i.e., the Münzenberger pipe 7 has a vast majority of its length “above” the top-most rib 8). Further, the pipe 7 of Münzenberger is a rigid plastic pipe capable of maintaining its integrity when subjected to a cast-in-concrete application, and the ribs 8 are “loss-preventing” means to keep the pipe 7 from sliding axially when concrete is poured in place. *Münzenberger* at column 4, lines 20-21. In stark contrast, the collar member 4 of Rodriguez is described as being flexible and pliable such that the collar member 4 can be stretched and distended upwardly to fit about pipes having various diameters. *Rodriguez* at column 3, lines 15-27. Thus, while groove 20 of Rodriguez may work with flexible and pliable material, it would have essentially no benefit if applied to the rigid pipe of Münzenberger. Significantly, Münzenberger teaches altering a height of the pipe 7 via cutting. *Münzenberger* at column 4, lines 13-15. Because the internal groove 20 of Rodriguez would not facilitate cutting of the pipe 7 of Münzenberger (as it would not be visible to a user performing a cutting operation), an expectation of success has not be established.

Conversely, if the Examiner is asserting that modifying Münzenberger in view of Rodriguez results in positioning the conically-shaped top portion of the Rodriguez roof flashing (e.g., that portion of the roof flashing “above” the upper edge seal 12 in FIG. 2 of Rodriguez) on top of the pipe 7 of Münzenberger, then it is respectfully submitted that there is no support for such a modification. For instance, if the top portion of the Rodriguez roof flashing were applied to the pipe 7 in Münzenberger, it would impede the passing of cable(s)/pipe(s) through the firestop pipe 7, thus rendering Münzenberger unsatisfactory for its intended purpose. Further, the pipe 7 of Münzenberger and the top portion of the Rodriguez roof flashing are made of dissimilar materials, making it highly expensive, if not impossible, to mount the top portion of Rodriguez onto the pipe 7 of Münzenberger.

**Appeal Brief to the Board of Patent Appeals and Interferences**

Applicant: DuWayne C. Radke et al.

Serial No.: 09/904,124

Filed: July 12, 2001

Docket No.: M120.199.101 (56908US002)

Title: PASS-THROUGH FIRESTOP DEVICE

---

In light of the above, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness for claim 1. Thus, Appellant requests that the Board reverse the rejections under 35 U.S.C. §103 of claims 1-4, 10, 15, 16, and 19.

**D. Other Claim Limitations Have Not Been Satisfied.**

**1. Independent claim 18**

Claim 18 requires, amongst other limitations, a firestop device having a housing including a plurality of frangibly connected circumferential bands having equal lengths. With this in mind, the above arguments relating to the non-analogous nature of Rodriguez, as well as the failure to establish a *prima facie* case of obviousness, are re-asserted. In addition, the Examiner has cited no teachings in Münzenberger or Rodriguez that would otherwise satisfy a plurality of frangibly connected circumferential bands, as otherwise required by independent claim 18. At best, Rodriguez suggests a single removable collar portion.

Even further, none of the cited references teach or suggest the plurality of frangibly connected bands having equal axial lengths. If the Examiner is interpreting the ribs 8 of Münzenberger as being the “bands of equal axial lengths” of claim 18, this interpretation requires that the ribs/bands 8 of Münzenberger be removable from a remainder of the pipe 7 in order to satisfy the limitations of claim 18. As previously described, there is no motivation or suggestion for this modification. In fact, such a modification would render Münzenberger unfit for its intended purpose, as Münzenberger teaches the ribs 8 serve as “loss preventing means for the cast-in-the concrete fixture.” *Münzenberger* at column 4, lines 19-21. If one or more of the ribs 8 were removed, this loss prevention means required by Münzenberger would be obviated. For these additional reasons, then, Appellant requests that the Board reverse the rejection under 35 U.S.C. §103 of claim 18.

**2. Dependent claim 2**

Claim 2 depends from claim 1, and recites that the band includes a pull tab. The Examiner has referenced the annular bead 25 of Rodriguez as satisfying this “pull tab” limitation. *Final Office Action* mailed September 22, 2004 at page 6, lines 6-8. Appellant

**Appeal Brief to the Board of Patent Appeals and Interferences**

Applicant: DuWayne C. Radke et al.

Serial No.: 09/904,124

Filed: July 12, 2001

Docket No.: M120.199.101 (56908US002)

Title: PASS-THROUGH FIRESTOP DEVICE

---

respectfully disagrees. The annular bead 25 of Rodriguez is not part of the “removable band” identified by the Examiner. In particular, the annular groove 20 is formed “above” the bead 25, such that when the upper portion of the collar member 4 is removed at the annular groove 20, the bead 25 remains in place. This fact is clearly evidenced by comparison of FIGS. 2 and 4 of Rodriguez, with FIG. 2 representing the collar member 4 prior to removal of the upper section, and FIG. 4 representing the collar member 4 following removal. In both illustrations, the annular bead 25 remains. Thus, the bead 25 of Rodriguez is not part of a “removable band,” such that claim 2 recites additionally allowable subject matter.

3. Dependent claim 16

Claim 16 ultimately depends from claim 1, and recites that the housing includes a retaining ring coded to indicate the quantity of firestop material provided. The Examiner has not identified any reference as teaching the limitation of “said retaining ring is coded to indicate the quantity of firestop material provided in the device” as otherwise required by dependent claim 16. Thus, it is respectfully submitted that claim 16 recites allowable subject matter.

**III. The Rejection of claims 1-4, 10, and 18 under the judicially-created Doctrine of Obviousness-Type Double Patenting over Radke et al., U.S. Patent No. 6,694,684 (“Radke”).**

Claims 1-4, 10, and 18 were rejected under the judicially-created Doctrine of Obviousness-Type Double Patenting. An appropriate Terminal Disclaimer relating to U.S. Patent No. 6,694,684 was submitted on November 22, 2004 concurrently with a Response to the Final Office Action. It is believed that entry of the Terminal Disclaimer as filed obviates the double-patenting rejections.

**IV. Conclusion**

In view of the above, Appellant asserts that Rodriguez is non-analogous art, and moreover, Appellant believes that the Examiner has failed to establish a *prima facie* case of obviousness. In addition, Appellant believes that the record supports that the rejections to

**Appeal Brief to the Board of Patent Appeals and Interferences**

Applicant: DuWayne C. Radke et al.

Serial No.: 09/904,124

Filed: July 12, 2001

Docket No.: M120.199.101 (56908US002)

Title: PASS-THROUGH FIRESTOP DEVICE

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independent claims 1 and 18 under 35 U.S.C. § 103(a) have been overcome. Dependent claims 2-4, 6, 7, 10, 15, 16, and 19 depend from independent claim 1, and thus, Appellant believes that the rejections of these dependent claims under 35 U.S.C. § 103(a) are also overcome.

Appellant respectfully submits that the Examiner has presented the best available references against the claimed subject matter of the pending application. The prosecution of the pending application has proceeded through five substantive Office Actions and subsequent Responses. For the reasons discussed above, the cited references neither anticipate nor render the claimed invention obvious. Therefore, Appellant respectfully requests that the rejections of claims 1-4, 6-7, 10, 15-16, and 18-19 be reversed.

Any inquiry regarding this Appeal Brief to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office should be directed to David B. Patchett at Telephone No. (651) 736-4713, Facsimile No. (651) 736-3833. In addition, all correspondence should continue to be directed to the following address:

**Appeal Brief to the Board of Patent Appeals and Interferences**

Applicant: DuWayne C. Radke et al.

Serial No.: 09/904,124

Filed: July 12, 2001

Docket No.: M120.199.101 (56908US002)

Title: PASS-THROUGH FIRESTOP DEVICE

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Respectfully submitted,

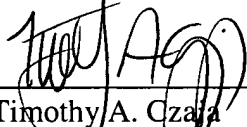
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**CERTIFICATE UNDER 37 C.F.R. 1.8:**

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 22<sup>nd</sup> day of February, 2005.

By 

Name: Timothy A. Czaja



**APPEAL BRIEF – APPENDIX**

Applicant: DuWayne C. Radke et al.

Serial No.: 09/904,124

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Docket No.: M120.199.101 (56908US002)

Title: PASS-THROUGH FIRESTOP DEVICE

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**IN THE CLAIMS**

1. A firestop device for providing a passage through a partition in a structure, comprising:
  - (a) a housing; and
  - (b) firestop material arranged within said housing;said housing including at least one frangible connection defining a removable band.
2. A firestop device as defined in claim 1, wherein said band includes a pull tab, said pull tab providing grasping means for allowing a user to remove said band from said housing at said frangible connection.
3. A firestop device as defined in claim 1, wherein said housing comprises a base portion and a riser portion, said base portion including a recess for receiving said firestop material, and said riser portion including said frangible connection.
4. A firestop device as defined in claim 3, wherein said base portion includes a sidewall portion extending from a first open end to toward said riser portion, and a shoulder portion extending inwardly from said sidewall portion to said riser portion, said sidewall portion and said shoulder portion defining said recess for receiving said firestop material.
5. A firestop device as defined in claim 4, wherein said sidewall and said shoulder portions include inner surfaces having ribs.
6. A firestop device as defined in claim 5, wherein said housing has first and second opposed open ends and a hollow chamber having a longitudinal axis extending from said first open end to said second open end.
7. A firestop device as defined in claim 6, wherein said first open end is provided in said base portion and said second open end is provided in said riser portion, said firestop material

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being provided in spaced relation along said sidewall portion inner surface from said first open end to said shoulder portion.

8. – 9.(Cancelled)

10. A firestop device as defined in claim 3, wherein said riser portion includes a plurality of equally segmented transverse bands each including a manually engageable pull tab.

11. A firestop device as defined in claim 10, wherein each said pull tab includes indicia indicating the length of the device at each band corresponding to the thickness of the partition.

12. A firestop device as defined in claim 11, further comprising a cap attached to said riser portion thereby to cover said second open end.

13. A firestop device as defined in claim 12, wherein said cap contains snap connectors that snap onto said riser portion, thereby to attach said cap to said riser portion.

14. A firestop device as defined in claim 11, further comprising an extension member adapted to connect with said riser portion adjacent said open second end.

15. A firestop device as defined in claim 3, further comprising a retaining ring arranged within said base portion first open end adjacent said firestop material.

16. A firestop device as defined in claim 15, wherein said retaining ring is coded to indicate the quantity of firestop material provided in the device depending on the application of the device.

17. A firestop device as defined in claim 11, further comprising an adapter connected with said base portion for coupling said device to a contoured surface.

**APPEAL BRIEF – APPENDIX**

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Title: PASS-THROUGH FIRESTOP DEVICE

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18. A firestop device for providing a passage through a partition in a structure comprising a housing having first and second opposed open ends and a hollow chamber having a longitudinal axis extending from said first open end to said second open end, said housing including a cylindrical base portion having a diameter and a cylindrical riser portion having a diameter smaller than said base diameter, said base portion including an annular sidewall portion extending from said first open end toward said riser portion and a shoulder portion extending radially inwardly from said sidewall portion to said riser portion, said sidewall portion and said shoulder portion defining an annular recess for receiving firestop material, said sidewall and said shoulder portions including inner surfaces having inwardly extending ribs, said riser portion including a plurality of longitudinally arranged frangibly connected circumferential bands having equal axial lengths, each band including a radially outwardly extending pull tab that can be used to manually remove a band from said riser portion along a frangible connection, thereby to reduce the height of the device in accordance with the thickness of the partition into which the device is installed.

19. A firestop device as defined in claim 2, wherein said pull tab extends radially outwardly from said band.

20. A firestop device as defined in claim 5, wherein said sidewall ribs extend longitudinally from said first open end along said shoulder portion along said inner surface, thereby defining a gap between said firestop material and said sidewall inner surface.

21.(Withdrawn)